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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,392	06/01/2001	Rian R. Maloney	021768.1089	2875

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EXAMINER
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DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/872,392

Applicant(s)

MALONEY, RIAN R.

Examiner

Harish T. Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,6-11,14-16 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-11,14-16 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21-26 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/7/03; 12/5/03</u> . | 6) <input checked="" type="checkbox"/> Other: <u>8/22/05; 7/9/02 (2pg)</u> .            |

### **DETAILED ACTION**

Claims 2, 4-5, 12-13, 17-19 are canceled.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 3, 6-11, 14-16 and 20, drawn to imaging checks, classified in class 705, subclass 45.

II. Claims 21-26, drawn to storing and indexing (database), classified in class 382 subclass 226.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because I is directed to risk management optimization, and invention II is directed to computer performing metadata mapping. The subcombination has separate utility such as integrating data.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

During a telephone conversation with Attorney Thomas Reger II (Reg. No. 47,892) on 02/24/2006 (returning my message) a provisional election was made with traverse to prosecute the invention of Group I (claims 1, 3, 6-11, 14-16 and 20). Affirmation of this election must be made by applicant in replying to this Office action. Group II (Claims 21-26) are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 6-11, 14-16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly;

For example, the following limitations of claim 1 are not clear: obtain the processing data generated for each check by the processing system; and determine whether processing data was previously generated for a specified check and, if processing data was previously generated for the specified check, to obtain at least a portion of the previous pass information for the specified check from the database via the processing system. These limitations are not clear to examiner, whether the

Art Unit: 3628

processing data is the image portion, data read from MICR, etc. Applicant is requested to explain these limitations in simple terms and point-out portion of the specification where these are explained. Similarly, claims 9 and 15 having same limitation.

Claim 15-16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, claim 15, for example, "logic stored" is not clear.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6-11, 14-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Cahill et al (hereinafter Cahill US 5,678,046).

Re. Claim 1, Cahill discloses an image capture host coupled to a sorter operable to sort a plurality of checks, to retrieve data from the checks and to record digital images of the checks, the image capture host operable to obtain the digital images of the checks recorded by the sorter [Figure 1 # 2, #5; col. 12 lines 49-56], a processing system

Art Unit: 3628

communicably coupled to the sorter and the image capture host and operable [col. 12 lines 49-56],

process each check based on the data retrieved from the check by the sorter in order to generate processing data for the check [col. 2 lines 52-67; col. 9 lines 5-15; col. 12 lines], and

to store previous pass information for each check for which processing data was previously generated, the previous pass information comprising at least a portion of the previously generated processing data [col. 12 line 48 to col. 13 line 11; col. 14 lines 22-30], and

at least one computer-processable medium storing a database external to the sorter and coupled to the image capture host, the database operable to store the digital images of the checks obtained by the image capture host and the previous pass information [Figure 2 # 621-614; col. 13 lines 25-34]; and

wherein the image capture host is further operable to: obtain the processing data generated for each check by the processing system [col. 5 line 62 to col. 6 line 8]; and determine whether processing data was previously generated for a specified check [col. 32 lines 21-26] and, if processing data was previously generated for the specified check, to obtain at least a portion of the previous pass information for the specified check from the database via the processing system [col. 35 lines 53; col. 32 lines 23-26; col. 20 line 57 to col. 21 line 10 (ref. Col. 20 port of the data is corrected)].

Art Unit: 3628

Re. Claim 3, Cahill discloses the image capture host further operable to generate an image record for storage in the database, the image record comprising at least a portion of the processing data for a specified check and the digital image of the specified check [Figure 2 # 610; col. 3 lines 1-14; col. 14 lines 57-67].

Re. Claim 6, Cahill discloses the image capture host further operable to generate an image record for storage in the database, the image record comprising at least a portion of the processing data for the specified check, the digital image of the specified check and, if processing data was previously generated for the specified check, at least a portion of the previous pass information for the specified check [col. 1 lines 7-18; col. 2 lines 27-38].

Re. Claim 7, Cahill discloses the sorter comprising a digital camera, the digital camera coupled to the image capture host and operable to record the digital images of the checks and to transmit the digital images of the checks to the image capture host [Figure 3; col. 17 lines 57-63 (see imager)].

Re. Claim 8, Cahill discloses the digital camera further operable to transmit the digital images of the checks to the image capture host using Transmission Control Protocol/Internet Protocol (TCP/IP) [col. 16 lines 2-15; col. 20 lines 14-23].

Art Unit: 3628

Re. Claim 9, Cahill discloses retrieving data from a plurality of checks at a sorter [Figure 1 # 2, #5; col. 12 lines 49-56]; processing each check based on the data retrieved from the check in order to generate processing data for the check [col. 16 lines 43-59 (sorter retrieves data by decoding the MICR line, the data is ); col. 2 lines 52-67]; determining whether processing data was previously generated for a specified, check [col. 32 lines 21-26]; obtaining at least a portion of previous pass information from a database external to, the sort for the-specified check if processing data was previously generated for the specified check, the previous pass information comprising at least a portion of the previously generated processing data [col. 35 lines 53; col. 32 lines 23-26; col. 20 line 57 to col. 21 line 10 (ref. Col. 20 port of the data is corrected)]; identifying a subset of the checks for imaging based on the processing data for each of the checks; recording digital images of the identified checks [Figure 3 # 202; col. 3 lines 1-15 (subset of checks are front image, back image and MICR data)]; obtaining the recorded digital images of the checks using TCP/IP [col. 16 lines 2-15; col. 20 lines 14-23]; and storing the obtained digital images of the checks in the database external to the sorter [Figure 2 # 610; col. 13 lines 25-33; col. 20 lines 14-23].

Re. Claim 10, Cahill discloses obtaining the recorded digital images of the checks comprising receiving the recorded digital images of the checks from a digital camera [Figure 3; col. 3 lines 28-30 (capturing = recording); col. 17 lines 43-63 (see imager)].



Art Unit: 3628

Re. Claim 11, Cahill discloses generating an image record for storage in the database, the image record comprising at least a portion of the processing data for a specified check and the digital image of the specified check [Figure 2 # 621-614; col. 12 line 48 to col. 13 line 34; col. 14 lines 22-30].

Re. Claim 14, Cahill discloses generating an image record for storage in the database, the image record comprising at least a portion of the processing data for the specified check, the digital image of the specified check and, if processing data was previously generated for the specified check, at least a portion of the previous pass information for the specified check [Figure2 # 610; col. 3 lines 1-14; col. 14 lines 57-67].

Re. Claim 15, Cahill discloses obtain digital images of a plurality of checks from a sorter using TCP/IP [col. 16 lines 2-15; col. 20 lines 14-23],

determine whether processing data was previously generated for a specified check and to obtain at least a portion of previous pass information from a database external to the sorter for the specified check if processing data was previously generated for the specified check, the previous pass information comprising at least a portion of the previously generated processing data [col. 35 lines 53; col. 32 lines 23-26; col. 20 line 57 to col. 21 line 10 (ref. Col. 20 port of the data is corrected)];

receive processing data for each check [col. 3 lines 31-33; col. 5 line 57 to col. 6 line 8];

generate an image record for storage in the database, the image record comprising processing data for a specified check and the digital image of the specified check [Figure 2 # 621-614; col. 13 lines 25-34; col. 32 lines 21-26]; and to provide the obtained digital images of the checks to the database external to the sorter for storage [Figure 2 # 621-614; col. 13 lines 25-34; col. 32 lines 21-26], and logic stored on at least one computer-processable medium (see software resident col. 5 line 66 to col. 6 line 8, which is loaded on the computer RAM or may be ROM).

Re. Claim 16, Cahill discloses obtain the digital images of the checks by receiving the digital images of the checks from a digital camera for the sorter [col. 5 line 66 to col. 6 line 8].

Re. Claim 20, Cahill discloses generate an image record for storage in the database, the image record comprising at least a portion of the processing data for the specified check, the digital image of the specified check and, if processing data was previously generated for the specified check, at least a portion of the previous pass information for the specified check [Figure 1 # 2, #5; col. 12 line 48 to col. 13 line 11; col. 14 lines 22-30].

### ***Conclusion***

Claims 2, 4-5, 12-13, 17-19 are canceled by preliminary amendment.

Claims 1, 3, 6-11, 14-16 and 20 are rejected.

Claims 21-26 are restricted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass  
Examiner  
Art Unit 3628



02/27/06